

Notice of Allowability	Application No.	Applicant(s)	
	10/031,198	NEEF ET AL.	
	Examiner	Art Unit	
	Barbara P. Badio, Ph.D.	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 12-14, 24, 26 and 27.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>4132004</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Barbara P. Badio, Ph.D.
 Primary Examiner
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DETAILED ACTION

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The specification has been amended as follows:

Page 1, after the title the following has been inserted:

-- This application is a 371 of PCT/DE00/02390 filed July 17, 2000. --

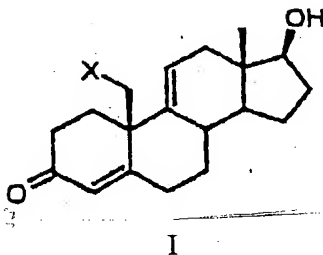
Authorization for this examiner's amendment was given in a telephone interview with Mr. James Ruland on April 8, 2004 and April 13, 2004.

The application has been amended as follows:

Claim 25 has been cancelled.

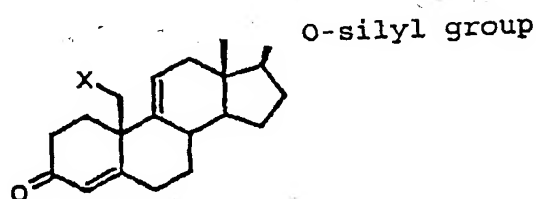
Claim 13 has been rewritten to read as follows:--

13: ~~A process for the production of 5 β -substituted~~
androst-9(11)-enes of general formula II according to claim 12 by reaction of a compound of
general formula I:



in which X = a halogen radical or a radiohalogen radical to form 17 β -silyl ether of formula Ia

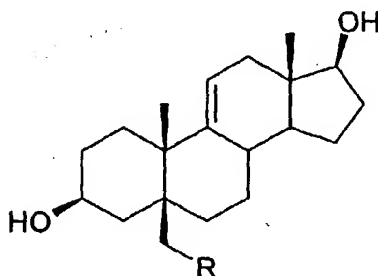
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Ia

in which X = halogen, selected from Br or I and further reaction with mercaptoacetic acid methyl ester for the formation of 17 β -silylated-3-oxo-2'H,5'H-thieno[3',4':5,10]-5 β -estr-9(11)-ene-2' ξ -carboxylic acid methyl ester, which then is reacted to form a target compound of

Formula II:



II

wherein radical R is:

$-(CH_2)_n-CH_2-R^1$, $-(CH_2)_n-CH_2-OR^1$, $-(CH_2)_n-CH_2-OCOR^1$, $-(CH_2)_n-CH_2-SR^1$, $-(CH_2)_n-CH_2-NR^1R^2$, $-(CH_2)_n-CHO$, $-(CH_2)_n-CN$, in which n can assume the values of 0-5, and radicals R^1 and R^2 , independently of one another, stand for hydrogen or a straight-chain or branched, saturated or unsaturated hydrocarbon radical with up to 18 C atoms, whereby this radical optionally can contain additional functional groups and carbocyclic or heterocyclic ring elements.

2. Claims 12-14, 24, 26 and 27 are allowed.

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Other Matters


3. The examiner notes for the record that (a) claim 25 was cancelled because it is a substantial duplicate of claim 14 and (b) claim 13 is being amended to correct formulae I and Ia.

Telephone Inquiry

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Barbara P. Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
April 13, 2004